

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DOUGLAS BENNETT GILBERG

Appeal No. 2004-1293
Application No. 09/989,330

ON BRIEF

Before GARRIS, WALTZ, and, DELMENDO, Administrative Patent Judges.

DELMENDO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 (2003) from the examiner's final rejection of claims 1 through 32 (final Office action mailed Dec. 18, 2002, paper 8), which are all of the claims pending in the above-identified application.¹

¹ In reply to the final Office action, the appellant submitted an amendment pursuant to 37 CFR § 1.116 (2003) (effective Feb. 5, 2001) (paper 9 filed Feb. 24, 2003), proposing a change to claim 17. The examiner, however, refused

The subject matter on appeal relates to a plant display (claims 1-29) and to a method of managing a plant display (claims 30-32). Further details of this appealed subject matter are recited in illustrative claims 1, 17, 18, and 30, the only independent claims on appeal, reproduced below:

1. A plant display comprising:
a transparent container having an inner surface defining an interior volume adapted to be at least partially occupied by a substantially transparent liquid;
a plant receptacle positioned at least partially within the interior volume of the transparent container in a manner so that at least a portion of the receptacle is below a surface of the liquid occupying the container when the container is at least partially occupied by the liquid, the receptacle resting on a bottom portion of the inner surface of the transparent container, the receptacle having an outer surface with at least one recess, the recess being at least partially occupied by a substrate medium;
the recess and substrate medium occupying the recess being adapted to hold a live plant growing therein, wherein the recess is located in a portion of the outer surface of the receptacle that is at least partially below the surface of the liquid occupying the container when the container is at least partially occupied by the liquid so that the plant is at least partially below the surface of the liquid when the plant is held in the recess and substrate medium occupying the recess.

17. A plant display comprising:
a transparent container having an inner surface defining an interior volume adapted to be at least partially occupied by a substantially transparent liquid; and a plant receptacle positioned at least

entry of this proposed amendment. (Advisory action mailed Mar. 6, 2003, paper 10.

partially within the interior volume of the transparent container in a manner so that at least a portion of the receptacle is below a surface of the liquid occupying the container when the container is at least partially occupied by the liquid, the receptacle having an outer surface with at least one recess, the recess being at least partially occupied by a substrate medium;

the recess and substrate medium occupying the recess being adapted to hold a live plant growing therein, wherein the recess is located in a portion of the outer surface of the receptacle that is at least partially below the surface of the liquid occupying the container when the container is at least partially occupied by the liquid so that the plant is at least partially below the surface of the liquid when the plant is held in the recess and substrate medium occupying the recess;

wherein the recess is located in a portion of the outer surface of the receptacle that is sufficiently near the surface of the liquid so that a majority of the plant is growing above the surface of the liquid, when the container is at least partially occupied by the liquid and when the plant is held in the recess.

18. A plant display comprising:

a transparent container having an inner surface defining an interior volume that is at least partially occupied by a substantially transparent liquid;

a plant receptacle positioned at least partially within the interior volume of the transparent container so that at least a portion of the receptacle is below a surface of the liquid, the receptacle resting on a bottom portion of the inner surface of the transparent container, the receptacle having an outer surface with a first recess that is at least partially occupied by a first substrate medium and a second recess that is at least partially occupied by a second substrate medium;

the first recess and first substrate medium being adapted to hold a first live plant growing therein, wherein the first recess is located in a portion of the outer surface of the receptacle that is below the surface of the liquid occupying the container when the container is at least partially occupied by the liquid

so that the first plant is at least partially below the surface of the liquid; and

the second recess and second substrate medium being adapted to hold a second live plant growing therein, wherein the second recess is located in a portion of the outer surface of the receptacle that is above the surface of the liquid occupying the container when the container is at least partially occupied by the liquid so that the second plant is above the surface of the liquid.

30. A method of managing a plant display comprising the steps of:

providing a transparent container having an inner surface defining an interior volume;

at least partially filling the interior volume of the container with a substantially transparent liquid;

providing a plant receptacle having an outer surface with at least one recess;

at least partially filling the recess with a substrate medium;

planting a live plant in the substrate occupying the recess; and

positioning the receptacle at least partially within the interior volume of the transparent container with the receptacle resting on a bottom portion of the inner surface of the transparent container and in a manner so that the recess is below a surface of the liquid occupying the container.

The examiner relies on the following prior art references as evidence of unpatentability:

Gillinder	715,571	Dec. 09, 1902
DiLernia	5,867,938	Feb. 09, 1999
Gates	6,179,218 B1	Jan. 30, 2001 (filed Feb. 02, 1999)

Satterlee Nursery, Planting Depths of Various Water Plants, at http://www.satterleenursery.com/planting_depth_diagram.gif (publication date unknown) (Satterlee).

The appealed claims stand rejected under 35 U.S.C. § 103(a) as follows:

- I. claims 1 through 11, 14 through 16, 18 through 27, and 30 through 32 as unpatentable over Gillinder (examiner's answer mailed Jun. 23, 2003, paper 13, pages 3-4; final Office action, pages 2-4);²
- II. claims 12, 13, 28, and 29 as unpatentable over Gillinder in view of DiLernia and Gates (answer, page 4; final office action, page 5); and
- III. claim 17 as unpatentable over Gillinder in view of Satterlee (answer, pages 4-5; final Office action, page 5).

We reverse rejections I and II but affirm rejection III. In addition, we enter a new ground of rejection pursuant to our authority under 37 CFR § 1.196(b) (2003) (effective Dec. 1, 1997).

² The statement of the rejection as set forth in the Jun. 23, 2003 answer omitted claims 2-11, 14-16, 18-27, and 30-32. In an order mailed Oct. 27, 2003 (paper 16), a Program and Administrator of the Board of Patent Appeals and Interferences required clarification of various matters including the omission of these claims. In response, the examiner indicates that claims 2-11, 14-16, 18-27, and 30-32 should have been rejected on this ground. (Supplemental examiner's answer mailed Jan. 14, 2004, paper 18, p. 3.) We note, however, that the examiner's issuance of a supplemental answer without our authorization pursuant to 37 CFR § 1.193(b) (1) (2003) (effective Dec. 1, 1997) is inappropriate. Under these circumstances, we will ignore the supplemental answer except as to clarification of matters specifically raised in the Oct. 27, 2003 order.

I. Claims 1-11, 14-16, 18-27, & 30-32: Gillinder

The examiner's rejection relies on Gillinder as the principal prior art reference. According to the examiner (answer, page 3), "Gillinder discloses the claimed invention, as cited in claims 1 and 30, except the plant receptacle does not sit on a bottom portion of the transparent container." Nevertheless, it is the examiner's position that "[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to place the receptacle C on a bottom portion of the transparent container A, since it has been held that rearranging parts of an invention involves only routine skill in the art." (Id.)

We cannot agree with the examiner's analysis and conclusion. As pointed out by the appellant (appeal brief filed May 14, 2003, paper 12, pages 13-14), Gillinder describes an aquarium plant-holder that does not interfere "with the freedom of the fish from the top to the bottom of the water, and vice versa..." (Lines 8-15.) Specifically, Gillinder teaches that the plant-holder includes radiating arms E which, in concert with the neck portion of the aquarium, support the plant-holder in suspension in the container. (Figures 1 and 2; lines 28-40.) Gillinder further teaches that the configuration of the plant-holder permits it to be "readily removed and reapplied" and that

the plants are prevented from spreading or crowding the neck portion of the aquarium because the top of the plant-holder is above the neck of the aquarium. (Emphasis added; lines 40-51.)

Given the particular requirements of the configuration and positioning of Gillinder's plant-holder, we share the appellant's view that one of ordinary skill in the art would not have been led to modify Gillinder's aquarium in the manner as proposed by the examiner. It is our judgment, therefore, that the examiner has not established a prima facie case of obviousness against appealed claims 1 through 11, 14 through 16, 18 through 27, and 30 through 32.

The examiner argues that Satterlee provides evidence of obviousness. (Answer, page 6.) We note, however, that Satterlee was not included in the statement of the rejection.³ Moreover, Satterlee relates to a water garden, not to an aquarium in which the object is to provide a plant holder that permits fish to swim freely from top to bottom and vice versa and prevents or reduces the possibility of the plant restricting the neck portion of the aquarium, as specifically described in Gillinder.

³ In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970) ("Where a reference is relied on to support a rejection, whether or not in a 'minor capacity,' there would

II. Claims 12, 13, 28, & 29: Gillinder, DiLernia, & Gates

Appealed claims 12, 13, 28, and 29 depend from either claim 1 or claim 18 and recite that at least a portion of the receptacle of the plant display is shaped to resemble an animal (claims 12 and 28) or a vegetable organism (claims 13 and 29). While the examiner relies on additional prior art references in the form of DiLernia and Gates for teachings relevant to limitations further recited in appealed claims 12, 13, 28, and 29 (answer, page 4), these references do not cure the basic deficiency in the examiner's rejection of independent claims 1 and 18. Accordingly, we reverse for the same reasons set forth above in our discussion of rejection I.

III. Claim 17: Gillinder and Satterlee

It is well settled that, in proceedings before the United States Patent and Trademark Office (PTO), claims in an application are to be given their broadest reasonable interpretation, taking into account the written description found in the specification. In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) ("During patent examination the pending claims must be interpreted as

appear to be no excuse for not positively including the reference in the statement of rejection.").

broadly as their terms reasonably allow."); In re Yamamoto, 740 F.2d 1569, 1571, 222 USPQ 934, 936 (Fed. Cir. 1984) ("The PTO broadly interprets claims during examination of a patent application since the applicant may 'amend his claim to obtain protection commensurate with his actual contribution to the art.'") (quoting In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550 (CCPA 1969)).

We are of the opinion that appealed claim 17 does not positively require the plant display to contain "a substantially transparent liquid" or "a live plant." The recitations "adapted to" and "when" clearly indicate to one skilled in the relevant art that the use of the terms "substantially transparent liquid" and "live plant" is merely for the purpose of defining further functional characteristics of and relationship between the transparent container and/or the plant receptacle.

Like the appellants' claimed plant display, Gillinder's aquarium is said to comprise a fish jar or aquarium A (i.e., "a transparent container having an inner surface defining an interior volume adapted to be at least partially occupied by a substantially transparent liquid") and, disposed within the aquarium, a plant holder C consisting of a vessel or flower pot D and radiating arms E in which are disposed sand, stone, or other matter as well as a plant (i.e., "a plant receptacle

positioned at least partially within the interior volume of the transparent container in a manner so that at least a portion of the receptacle is below a surface of the liquid occupying the container when the container is at least partially occupied by the liquid, the receptacle having an outer surface with at least once recess, the recess being at least partially occupied by a substrate medium"). When Gillinder's plant holder is provided with a sufficiently tall plant, which is not specifically required as a component of the plant display in appealed claim 17, the majority of the plant would necessarily be located under water, as required by appealed claim 17. Accordingly, Gillinder describes, either expressly or inherently, each and every limitation of appealed claim 17. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997).

Although the examiner's rejection of appealed claim 17 has been made under 35 U.S.C. § 103(a), a prior art disclosure that anticipates under 35 U.S.C. § 102 also renders the claim obvious, for anticipation is the epitome of obviousness. In re Baxter Travenol Laboratories, 952 F.2d 388, 391, 21 USPQ2d 1281, 1284-85 (Fed. Cir. 1991); In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982); In re May, 574 F.2d 1082, 1089, 197 USPQ 601, 607 (CCPA 1978).

Summary of Disposition of Examiner's Rejections

In summary, we reverse the examiner's rejections under 35 U.S.C. § 103(a) of: (i) appealed claims 1 through 11, 14 through 16, 18 through 27, and 30 through 32 as unpatentable over Gillinder; and (ii) appealed claims 12, 13, 28, and 29 as unpatentable over Gillinder in view of DiLernia and Gates. We affirm, however, the examiner's 35 U.S.C. § 103(a) rejection of appealed claim 17 as unpatentable over Gillinder in view of Satterlee.

The decision of the examiner is therefore affirmed in part.

New Grounds of Rejection

We enter the following new grounds of rejection.

A. Claims 1 through 3, 6 through 11, 16, 17, and 30 are rejected under 35 U.S.C. § 102(b) as anticipated by British patent application GB 2 059 280 A published in the name of inventor James on Apr. 23, 1981, already of record.

James describes a filtration system for an aquarium comprising a hollow shell 11 resting on the bottom of the aquarium and including one or more depressions 18 filled with gravel in which live plants may be grown. (Figure 1; page 1, lines 116.) James further teaches that the hollow shell may be polymeric and that the outer upper surface of the hollow shell

may have an external appearance of a natural object such as a rock or log. (Page 2, lines 18-24.)

From these teachings, we determine that James describes, either expressly or inherently, each and every limitation of claims 1 through 3, 6 through 11, 16, 17, and 30 within the meaning of 35 U.S.C. § 102(b). In re Schreiber, 128 F.3d at 1477, 44 USPQ2d at 1431.

B. Claims 12, 13, 18, 22, 24, 26 through 29, 31, and 32 are rejected under 35 U.S.C. § 103(a) over James.

Claims 12 and 13 recite that at least a portion of the receptacle is shaped to resemble an animal and a "vegetable organism," respectively. As we discussed above in rejection A, James teaches that the outer upper surface of the hollow shell may be in the form of any natural object. Thus, we determine that one of ordinary skill in the art would have found it prima facie obvious to mold the hollow shell of James in the form of any natural object such as an animal or a vegetable.

Claims 18, 22, 24, and 26 through 29 require two recesses, one of which is below the surface of the liquid when the container is at least partially filled and the other above the surface of the liquid. As we indicated above, James teaches one or more hollow shells. One of ordinary skill in the art would have found it prima facie obvious to provide at least one hollow

shell that is higher than another in order to obtain a natural and aesthetically pleasing appearance.

Claim 31 recites that the receptacle is positioned in the transparent container after the recess is partially filled with substrate medium and a live plant is planted, while claim 32 recites removing the plant display from the aquarium for cleaning purposes. Although James does not specifically disclose these steps, we determine that one of ordinary skill in the art would have carried out the recited steps in the normal use of James's aquarium in order to facilitate the positioning of the filter system in the aquarium as well as its periodic cleaning and maintenance.

C. Claims 4, 5, 23, and 25 are rejected under 35 U.S.C. § 103(a) as unpatentable over the combined teachings of James and U.S. Patent 4,117,805 issued to Ward on Oct. 3, 1978, already of record.

Claims 4, 5, and 25 recite a transparent container having a "convex configuration so that, when viewed from outside the container through the convex portion, contents of the container appear magnified" or "a generally spherical bowl." Ward teaches an aquarium having a generally spherical bowl shape. (Figure 1.) Thus, it is our judgment that one of ordinary skill in the art would have been led to combine the teachings of James with

Ward to arrive at an aquarium encompassed by claims 4 and 5. Specifically, one of ordinary skill in the art would have found it prima facie obvious to manufacture James's aquarium in the shape of a generally spherical bowl as shown in Ward with a reasonable expectation of obtaining the aesthetic qualities attributable to such an aquarium having a generally spherical shape.

Claim 23 recites that "the contents of the second recess are isolated from the liquid occupying the container." Ward teaches that an aquarium may be provided with a terrarium to sustain terrestrial living plants and animals. (Column 1, lines 30-36.) Accordingly, one of ordinary skill in the art would have found it prima facie obvious to provide a terrarium in the aquarium of James as suggested by Ward in order to sustain terrestrial plant life.

D. Claims 14, 15, and 19 through 21 are rejected under 35 U.S.C. § 103(a) as unpatentable over the combined teachings of James and U.S. Patent 4,074,997 issued to Cohen on Feb. 21, 1978, copy attached.

Claims 14, 15, and 19 through 21 recite that the substrate medium is a "synthetic material, comprises "fiberglas batting," or is "an organic material." Cohen teaches aquarium plant substrates are known in the art to include organic material such

as peat, organic polymers, and fibrous materials. (Column 1, line 5 to column 3, line 51; Examples 1-34.) Thus, we determine that one of ordinary skill in the art would have found it prima facie obvious to use substrates including organic material such as peat, organic polymers, and fibrous materials (e.g., fiberglass batting) as suggested by Cohen in James in order to enhance the growth of the live plants in an aquarium.

Time for taking action

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b). 37 CFR § 1.196(b) provides that "[a] new ground of rejection shall not be considered final for the purposes of judicial review." 37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise ONE (1) of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner...

(2) Request that the application be reheard under 37 CFR § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record...

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No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR §
1.136(a).

AFFIRMED IN PART
37 CFR § 1.196(b)

Bradley R. Garris)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
Thomas A. Waltz)	
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
)	
)	
Romulo H. Delmendo)	
Administrative Patent Judge)	

rhdlp

Appeal No. 2004-1293
Application No. 09/989,330

THOMPSON COBURN LLP
ONE US BANK PLAZA
SUITE 3500
ST LOUIS MO 63101